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Revised PTO/SB/50 (08-00)

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Attorney Docket No. 33229-200167

REISSUE PATENT APPLICATION TRANSMITTAL

Address to: Commissioner for Patents P. O. Box 1450 Patent Application Alexandria, VA 22313-1450	Attorney Docket No.	33229-200167
	First Named Inventor	Xin LIU
	Original Patent Number	6,468,542
	Original Patent Issue Date (Month/Day/Year)	October 22, 2002
	Express Mail Label No.	

APPLICATION FOR REISSUE OF:
(check applicable box)

☒ Utility Patent

☐ Design Patent

☐ Plant Patent

APPLICATION ELEMENTS (37 CFR 1.173)

1. ☒ * Fee Transmittal Form (e.g., PTO/SB/56)
(Submit an original, and a duplicate for fee processing)
2. ☒ Applicant claims small entity status. See 37 CFR 1.27.
3. ☒ Specification and Claims in a double column copy of patent format (amended, if appropriate)
4. ☐ Drawing(s) (proposed amendments, if appropriate)
5. ☒ Reissue Oath / Declaration (original or copy)
(37 C.F.R. § 1.175)(PTO/SB/51 or 52)
6. Original U.S. Patent currently assigned?
☐ Yes ☒ No

(If Yes, check applicable box(es))

☐ Written Consent of all Assignees (PTO/SB/53)

☐ 37 C.F.R. § 3.73(b) Statement (PTO/SB/96) ☐ Power of Attorney

ACCOMPANYING APPLICATION PARTS

7. ☒ Statement of status/support for all changes to the claims. See 37 CFR 1.173(c).
8. ☐ Original U.S. Patent for surrender
☐ Ribbioned Original Patent Grant
☐ Statement of Loss (PTO/SB/55)
9. ☐ Foreign Priority Claim (35 U.S.C. 119)
(if applicable)
10. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
11. ☐ English Translation of Reissue Oath/Declaration (if applicable)
12. ☒ Preliminary Amendment
13. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
14. ☒ Other:
PETITION UNDER RULE 1.47(a):
Statement of Non-assignment

14. CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label 26694 or ☐ Correspondence address below

Name	VENABLE				
Address	P.O. Box 34385				
City	Washington	State	D.C.	Zip Code	20043-9998
Country	U.S.A.	Telephone	(202) 344-4000	Fax	(202) 344-8300

NAME (Print/Type)	Fei-Fei Chao	Registration No. (Attorney/Agent)	43,538
Signature	<i>Fei-Fei Chao</i>	Date	Jan. 14, 2004

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Box Patent Application, Alexandria, VA 22313-1450.

PC Docs No. 514050

VENABLE
ATTORNEYS AT LAW

REISSUE APPLICATION FEE TRANSMITTAL FORMDocket Number (Optional)
33229-200167

Claims as Filed - Part 1

Claims in Patent	For	Number Filed in Reissue Application	(3) Number Extra	Small Entity		Other than a Small Entity	
				Rate	Fee	Rate	Fee
(A) 10	Total Claims (37 CFR 1.16(j)) Independent Claims (37 CFR 1.16(i))	(B) 20	**** 0	X\$ _____ =		or	X\$ _____ =
(C) 1		(D) 1	* 0				X\$ _____ =
Basic Fee (37 CFR 1.16(h))					\$385		\$ _____
Total Filing Fee					\$385	OR	\$ _____

Claims as Amended - Part 2

	(1) Claims Remaining After Amendment		(2) Highest Number Previously Paid For	(3) Extra Claims Present	Small Entity		Other than a Small Entity	
					Rate	Fee	Rate	Fee
Total Claims (37 CFR 1.16(j))	***	MINUS	** 20	*	X\$ _____ =	or	X\$ _____ =	
Independent Claims (37 CFR 1.16(i))	***	MINUS	***** 1	=	X\$ _____ =		X\$ _____ =	
Total Additional Fee					\$	OR	\$ _____	

* If the entry in (D) is less than the entry in (C), Write "0" in column 3.

** If the "Highest Number of Total Claims Previously Paid For" is less than 20, Write "20" in this space.

*** After any cancelation of claims

**** If "A" is greater than 20, use (B - A); if "A" is 20 or less, use (B - 20).

***** "Highest Number of Independent Claims Previously Paid For" or Number of Independent Claims in Patent (C).

☒ Applicant claims small entity status. See 27 CFR 1.27.☐ Please charge Deposit Account No. _____ in the amount of _____.
A duplicate copy of this sheet is enclosed.☒ The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 or 1.17 which may be required, or credit any overpayment to Deposit Account No. 22-0261.
A duplicate copy of this sheet is enclosed.☒ A check in the amount of \$ 515 to cover the filing / additional fee is enclosed.☐ Payment by credit card. Form PTO-2038 is attached.**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on form PTO-2038.**

Jan. 14, 2004

Date

Fei-Fei Chao
Signature of Applicant, Attorney or Agent of Record

Fei-Fei Chao, Ph.D.

Typed or printed name

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION OF :

Xin LIU and Chee-Keung CHUNG

Patent No. : 6,468,542

TC/A.U. : 1651

Issued : October 22, 2002

Examiner : TATE, C.

For : GERMINATION ACTIVATED *GANODERMA LUCIDUM* SPORES AND
METHOD FOR PRODUCING THE SAME

Docket No. : 33229-200167

Customer No. ***26694***

PATENT TRADEMARK OFFICE

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313
Mail Stop REISSUE

**STATEMENT OF ERROR(S) TO BE RELIED UPON
AS THE BASIS FOR REISSUE UNDER 37 CFR § 1.175**

Sir:

Applicant files this statement in connection with the filing of the above-identified reissue application to satisfy the requirements under 37 CFR § 1.175.

Applicant believes the original patent to be partly inoperative or invalid by reason of the patentees of U.S. Patent No. 6,468,542 (the '542 patent) claiming more or less than patentees had the right to claim in the patent as follows:


1. As shown in the newly added claims 11-20 (see Preliminary Amendment accompanying the reissue application), the '542 patent fails to claim the characteristics and utility of the pharmaceutical preparation, which are important to the patentability of this invention. Please note that the newly added claims 11-20 do not seek to enlarge the

scope of the '542 patent, although this reissue application is filed within 2 years after the issuance of the '542 patent.

2. As stated in the "Petition Under Rule 1.47(a)" which accompanies this reissue application, one of the original inventors of the '542 patent, Mr. Xin Liu, unilaterally filed a reissue application without notifying the Applicant of this reissue application, seeking to remove Applicant's rights as an owner of the '542 patent. On information and belief, the PTO not only wrongfully accepted and prosecuted Mr. Liu's reissue application (RE 10/376,692), but also denied Applicant's rights to participate in Mr. Liu's reissue application. This reissue application is filed in part to ensure that Dr. Chung's rights as an owner of the '542 patent enable him to file a reissue application to correct the deficiencies in the '542 patent.

Applicant respectfully submits that all errors which are being corrected in the above-identified reissue application up to the time of the filing of the oath/declaration arose without any deceptive intention on the part of the Applicant.

Respectfully submitted,

A handwritten signature in black ink that reads "Fei-Fei Chao". The signature is written in a cursive, flowing style.

Fei-Fei Chao, Ph.D.
Reg. No. 43,538

Date: January 14, 2004
Fei-Fei Chao, Ph.D.
Venable LLP
575 7th Street, NW
Washington, D.C. 20004
Tel.: (202) 344-8011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION OF :

Xin LIU and Chee-Keung CHUNG

Patent No. : 6,468,542

TC/A.U. : 1651

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For : GERMINATION ACTIVATED *GANODERMA LUCIDUM* SPORES AND
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Docket No. : 33229-200167

Customer No. ***26694***

PATENT TRADEMARK OFFICE

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313
Mail Stop REISSUE

**PETITION TO FILE A REISSUE APPLICATION WHEN AN INVENTOR
REFUSES TO SIGN OR CANNOT BE REACHED UNDER RULE 1.47(a)**

Sir:

This Petition is filed under 37 C.F.R. § 1.47(a) and in accordance with the guidance given in MPEP 409.03(c) to request that the above-identified re-issue application of U.S. Patent No. 6,468,542 (hereinafter the '542 patent) be granted a filing date and forwarded for examination. The factual evidence leading to the filing of this re-issue application is described as follows:

1. The '542 patent was filed under two inventors' names, Dr. Chee-Keung Chung (hereinafter "the Applicant" or "Dr. Chung") and Mr. Xin Liu (hereinafter "Mr. Liu"), on March 12, 2001, as a Divisional Application of U.S. Serial No. 09/524,508, filed on March 13, 2000, now U.S. Patent No. 6,316,002 (hereinafter the '002 patent). Both the '002 and the '542 patents

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claim the priority of U.S. Provisional Application No. 60/158,377 (hereinafter the '377 application), filed on Oct. 12, 1999. The undersigned attorney was the attorney of record for the '377 application, the '002 patent, and the '542 patent. The oath/declaration in connection with the filing of the '002 patent (which was used in filing the '542 patent) was signed by two inventors, each of whom provided a power of attorney for the undersigned attorney. A copy of the oath/declaration signed by both inventors in connection with the application for the '542 patent is attached as Exhibit 1.

2. There has been no assignment of the '377 application, the '002 patent and the '542 patent.

3. Prior to and at the time of the filing of these patent applications in the U.S. and counterpart applications worldwide, Dr. Chung and Mr. Liu had a friendly business relationship.

4. On information and belief, on or around July 2002, the business relationship between Dr. Chung and Mr. Liu began to deteriorate. On or about February 27, 2003, unknown to Dr. Chung, Mr. Liu retained counsel Mr. Otto Lee (Registration No. 37,871) of the Intellectual Property Law GRP LLP, having a business address of 12 South First St. Ste. 1205, San Jose, CA 95113 (Tel: 408-286-8933), to unilaterally file a reissue application of the '542 patent (Re. S.N. 10/376,692) (hereinafter "Mr. Liu's reissue application").

5. Mr. Liu's reissue application sought to name himself as the sole inventor of the '542 patent by asking the PTO to remove any additional inventor named in the '542 patent. Mr. Liu never mentioned Dr. Chung's name in his reissue application. Also, no evidence was provided by Mr. Liu with regard to his claim of a sole ownership interest in the '542 patent.

6. Dr. Chung and the undersigned were never notified about Mr. Liu's filing of a reissue application either by Mr. Liu's attorney or by the PTO.

7. On or around May 2003, the parties, individually and/or through their respective organization and trade company, filed separate lawsuits against each other. On information and belief, these lawsuits are currently pending.

8. Dr. Chung did not learn about Mr. Liu's reissue application until Mr. Liu filed an affirmation in connection with a lawsuit presently pending at the High Court in Hong Kong in December 2003. Dr. Chung immediately notified the undersigned, who in turn immediately left Examiner Christopher R. Tate (who at the time was on vacation) a voice message on December 24, 2003, after completing a search on the Official Gazette to confirm Mr. Liu's filing of the reissue application. On December 29, 2003, the undersigned placed a telephone call to Mr. Otto Lee, the attorney of record for Mr. Liu's reissue application. Mr. Lee indicated that he had very little recollection of this case because it was handled by an associate who was on vacation at that time. Mr. Lee promised that he would contact the undersigned on or about January 2, 2004, when the associate returned to work.

9. On January 6, 2004, the undersigned spoke to Examiner Tate, who indicated that he was not at liberty to discuss this matter with the undersigned because the undersigned is not the attorney of record for Mr. Liu's reissue application. Examiner Tate recommended that the undersigned talk to Examiner Bill Dixon in the Special Program Branch who handles reissue applications.

10. On January 7, 2004, the undersigned spoke to Examiner Dixon, who indicated that although he could understand the frustration experienced by the undersigned and Dr. Chung, he regretted that he could not be of any assistance because the PTO rules and regulations did not provide for any recourse for an inventor in a situation like this. The undersigned objected, pointing out that the '542 patent does not have any assignee, so that both Mr. Liu and Dr. Chung

share equal rights in the patent under 35 U.S.C. § 262, and that since a reissue application can ONLY be filed "through error without any deceptive intention" under 35 U.S.C. § 251 and 37 CFR § 1.175, there was no reason for the PTO to accept RE 10/376,692 because the application on its face was defective and deceptive (i.e., only one out of two inventors has signed the Oath/Declaration). Examiner Dixon advised the undersigned to contact the Office of Petitions for assistance.

11. The undersigned then placed a telephone call to the Office of Petitions and spoke to Examiner Karen Ferreti on January 7, 2004, who indicated that she agreed with the undersigned that the PTO obviously made a mistake in accepting Mr. Liu's reissue application because it contains an improper Oath/Declaration, but before she could provide any advice, she needed to review the files and speak with the Examiner. Until today, the undersigned has not received a return call from Ms. Ferreti.

12. On January 12, 2004, the undersigned telephoned Mr. Otto Lee again to ask him whether he would be willing to accept documents for Mr. Liu. The undersigned told Mr. Lee that Dr. Chung intended to file his own reissue application with the PTO. Mr. Lee told the undersigned that he would be glad to accept the documents for his client, Mr. Liu. On the same date, the undersigned sent Mr. Lee a cover letter, a prepared Reissue Oath/Declaration Form (with signature lines of both Mr. Liu and Dr. Chung) and a "Preliminary Amendment, Status of Claims, and Statement of Support" document. In the cover letter, the undersigned requested that Mr. Lee let her know whether or not Mr. Liu would sign the Oath/Declaration Form on or before January 14, 2004. A copy of the cover letter to Mr. Otto Lee is attached as Exhibit 2.

13. In the meantime, on January 13, 2004, the undersigned filed a Petition under 37 CFR § 1.182 and a Protest under 37 CFR § 1.291, alerting the PTO that Mr. Liu's reissue

application was improperly filed and did not meet all of the requirements of 35 U.S.C. § 251, and that should the PTO grant Mr. Liu's reissue application, Dr. Chung's ownership rights in the '542 patent will be compromised. A copy of the Petition and Protest filed by the undersigned is attached as Exhibit 3.

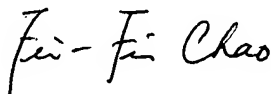
14. On January 14, 2004, around 3:30 pm, Mr. Lee telephoned the undersigned to tell her that he had spoken to Mr. Liu's counsel in Hong Kong about the undersigned's request. According to Mr. Lee, Mr. Liu's counsel in Hong Kong indicated that she would advise Mr. Liu not to sign the Oath/Declaration Form at this time. Therefore, Mr. Lee advised the undersigned to file this Petition claiming that Mr. Liu refused to sign the Oath/Declaration Form. Mr. Lee also indicated that should Mr. Liu change his position, he will inform the undersigned by telephone immediately.

It is Applicant's position that the PTO's unilateral action to accept Mr. Liu's filing of the reissue application to remove Dr. Chung as an inventor has exceeded its statutory authority, which constitutes a reckless and callous disregard of Dr. Chung's rights under the U.S. patent laws. See, e.g., Baker Hughes Inc. v. Kirk, 38 USPQ2d 1885 (D.D.C. 1995); In re Goldstein, 16 USPQ2d 1963 (Comm. Pat. Trademarks 1990); Ethicon Inc. v. U.S. Surgical Corp., 45 USPQ2d 1545 (Fed. Cir. 1998).

Also, because Mr. Liu's counsel has informed the undersigned that Mr. Liu will not cooperate with Dr. Chung in filing this reissue application, Applicant hereby requests that this Petition be filed in Dr. Chung's name alone under 37 CFR § 1.47(a). After the filing of this reissue application, a complementary copy of all documents filed with the PTO will be sent to Mr. Otto Lee, who in turn has agreed to forward all documents to Mr. Liu to keep him informed with regard to the development of this case.

In view of the above, it is respectfully requested that the filing of the Oath/Declaration and Statement of Non-Assignment with one out of two inventors' signatures, together with a check which covers the petition fee of \$130 under 37 CFR § 1.17(i) and the basic filing fee, be accepted and that the application be considered on the merits. If no check is attached or if the check is for an insufficient amount, please charge the balance due to our Deposit Account No. 22-0261.

Respectfully submitted,

A handwritten signature in cursive script that reads "Fei-Fei Chao".

Fei-Fei Chao, Ph.D.
Reg. No. 43,538

Date: January 14, 2004
Fei-Fei Chao, Ph.D.
Venable LLP
575 7th Street, NW
Washington, D.C. 20004
Tel.: (202) 344-8011

DC2DOCS#514053

Practitioner's Docket No.: Richards.Liu.RE2
Application No.: 10/376,692

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Box SN
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37. C.F.R. § 1.182 TO WAIVE THE TWO MONTH DELAY
PROVIDED BY MPEP § 1441 AND ACCEPT THE PROTEST PURSUANT
35 U.S.C. § 291

1. Applicant hereby petitions for acceptance of the Protest pursuant 35 U.S.C. § 291 and to waive the more than two month delay in its filing.
2. A Reissue Application has been filed with the object of deleting one of the two named co-inventors. The Reissue Application was not filed by an Assignee having an entire interest in the patent being reissued but rather was filed by only one of the named co-inventors.
3. Both of the named inventors on the patents were partners. There has been a recent falling out between them. There was no specific notice given to the "deleted" inventor of the filing of the reissue application by the other co-inventor or his representative. The only notice would have been through the O.G..
4. The undersigned discovered the existence of the reissue application in a search of the O.G.'s on December 24, 2003.
5. Fee (37 C.F.R. § 1.17 (h)):

The fee of \$130.00 for this request is paid as follows:

☐ Attached is a check for \$130.00

☒ Charge Account 22-0261 the sum of \$130.00.
A duplicate of this request is attached.

Jan. 13, 2004
Date

Fei-Fei Chao, Ph.D.
(type or print name of person signing)

Fei-Fei Chao
Signature

P.O. Box 34385
Washington, DC 20043-9998
P.O. Box of Signatory